

**AMENDMENT TO THE AMENDMENT IN THE
NATURE OF A SUBSTITUTE TO H.R. 9
OFFERED BY MR. JOHNSON OF GEORGIA**

Page 5, strike lines 14 through 22, and insert the
following (and redesignate the subsections accordingly):

1 “(a) AWARD.—In connection with a civil action in
2 which any party asserts a claim for relief arising under
3 any Act of Congress relating to patents, upon motion by
4 a prevailing party, the court shall determine whether the
5 position of the non-prevailing party was objectively reason-
6 able in law and fact, and whether the conduct of the non-
7 prevailing party was objectively reasonable. If the court
8 finds that the position of the non-prevailing party was not
9 objectively reasonable in law or fact or that the conduct
10 of the non-prevailing party was not objectively reasonable,
11 the court shall award reasonable attorney fees to the pre-
12 vailing party unless special circumstances, such as undue
13 economic hardship to a named inventor or an institution
14 of higher education (as defined in section 101(a) of the
15 Higher Education Act of 1965 (20 U.S.C. 1001(a))),
16 would make an award unjust. The prevailing party shall
17 bear the burden of demonstrating that the prevailing party
18 is entitled to an award.

1 “(b) DE MINIMIS AND IMMATERIAL EXCEPTION FOR
2 AWARD.—The court may not award attorney fees under
3 this section based on allegedly unreasonable litigation po-
4 sitions or actions of non-prevailing parties that are de
5 minimis or are not material to the consideration or out-
6 come of the litigation.”.

